REMARKS

The Non-Final Office Action mailed April 3, 2009, has been received and reviewed. Prior to the present communication, claims 1-31 were pending in the subject application. All pending claims stand rejected under 35 U.S.C. § 102(e), while claims 20-31 stand rejected under 35 U.S.C. § 101. In response, each of claims 1-8, 10-13, 20, 21, and 23-25 has been amended herein, while no claims have been canceled or added. As such, claims 1-31 remain pending. It is submitted that no new matter has been added by way of the present amendments. Reconsideration of the subject application is respectfully requested in view of the above amendments and the following remarks.

Objection of the Abstract

The Office Action states that the Abstract is objected to because the language should be clear and concise and should not repeat information given in the title. Specifically, the Office indicates the Abstract should avoid using phrases which can be already implied, such as the phrase "The present invention provides." Appropriate correction has been taken to remove the phrase from the Abstract.

Support for Claim Amendments

Independent claims 1, 7, and 20 have been amended herein to recite a clarification of the generation, composition, and function of the carrier virtual network. In particular, this clarification recites that the "carrier virtual network" includes "layer one resources dedicated from a plurality of dedicating telecommunication networks to the carrier virtual," where "the carrier virtual network is accessible by at least one accessing telecommunication network," and where "the plurality of dedicating telecommunication networks and the at least one accessing telecommunication network each represent particular telecommunication networks of layer one

resources exclusive from the others and owned by a respective service provider." Support for these claim amendments may be found in the Specification, for example, paragraphs [0005] and [0045]-[0049].

In general, amendments to the claimed subject matter are not "new matter" within meaning of 35 U.S.C. § 132 or Rule 118 of Patent Office Rules of Practice, unless they disclose an invention, process, or apparatus not theretofore described. Further, if later-submitted material simply clarifies or completes prior disclosure, it cannot be treated as "new matter."[1] By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, "a patent application *necessarily discloses* that function, theory or advantage, even though it says nothing explicit concerning it" (emphasis added).[2] The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter.[3] Accordingly, because these amendments are explicitly discussed, and/or inherent to, the procedure of re-provisioning telecommunication connections in a carrier virtual network based on latency information, as memorialized in the Detailed Description, the newly recited subject matter is encompassed by the scope of the Specification and does not constitute new matter.

Rejections based on 35 U.S.C. § 101

Claims 20-31 stand rejected under 35 U.S.C. § 101 for being directed toward non-statutory subject matter. In particular, the Office asserts claim 20 is directed to at least one machine readable media, which would have been reasonably interpreted as software alone and,

[1] *Triax Co. v Hartman Metal Fabricators, Inc.*, 479 F2d 951 (1973, CA2 NY); cert. denied, 94 S. Ct. 843 (1973).
[2] *See* MPEP § 2163.07; *In re Reynolds*, 443 F.2d 384 (CCPA 1971); *In re Smythe*, 480 F. 2d 1376 (CCPA 1973).
[3] *See id.*

thus, lacks the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of U.S.C. § 101. Further, the Office asserts that claim 20 is not a series of steps or acts (not a process) nor is it a combination of chemical compounds (not a composition of matter). As such, the Office concludes that claim 20 fails to fall within any statutory category delineated by the judicial interpretations of § 101.

In response, independent claim 20 is amended to recite the feature of "machine readable media containing machine readable code embodied thereon that, *when executed by a computer*, causes a carrier virtual network system to perform a method" (emphasis added). In addition, claim 20 is amended to recited the step of "*utilizing the computer* to identify connections using layer one resources available to the carrier virtual network" (emphasis added). This amendment finds support in the Specification, at least, in paragraph [00127] (describing the use of a computer or other machine for executing computer readable media).

It is contended that claim 20, as amended, falls within the statutory subject matter of § 101, because claim 20 now is drawn to a process that is tied to a particular machine or apparatus.[4] That is, by claiming a computer in the preamble and the body of claim 20, the method of claim 20 is tied to a particular apparatus. Accordingly, claim 20 and the claims that depend therefrom fall within the statutory requirements of § 101.

35 U.S.C. § 102 Anticipation Rejection based on U.S. Publication No. 2009/0070454 to McKinnon III et al.

Claims 1-31 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Publication No. 2009/0070454 to McKinnon, III et al. (hereinafter the "McKinnon reference"). As the McKinnon reference does not describe, either expressly or inherently, each and every

[4] *See In re Bilski*, 88 U.S.P.Q.2d 1385 (Fed. Cir. 2008).

element of amended claims 1-31, the Applicants respectfully traverse the rejection of these claims, as hereinafter set forth.

Independent claims 1, 7, and 20, as amended hereinabove, recite a clarification of the generation, composition, and function of the carrier virtual network. In particular, this clarification recites that the "carrier virtual network" includes layer one resources dedicated from a plurality of dedicating telecommunication networks to the carrier virtual, where "the carrier virtual network is accessible by at least one accessing telecommunication network," and where "the plurality of dedicating telecommunication networks and the at least one accessing telecommunication network each represent particular telecommunication networks of layer one resources exclusive from the others and owned by a respective service provider." In this way, layer one resources (e.g., digital cross connects, optical switches, electrical switches, and other physical resources used to provide telecommunication services) of a myriad of disparate telecommunications networks, which are each owned by a distinct service provider, are shared by being dedicated to, and managed by, a carrier virtual network.[5] Further, a third party ("accessing telecommunications network" that comprises layer one resources owned by service provider distinct from the others), which may or may not have dedicated layer one resources to the carrier virtual network, is allowed access thereto based on the criteria recited by claims 1, 7, and 20.

Anticipation "requires that the same invention, including each element and limitation of the claims, was known or used by others before it was invented by the patentee."[6] "[P]rior knowledge by others requires that all of the elements and limitations of the claimed

[5] Specification at page 4, ¶ [0032].
[6] MPEP § 2131, *passim*; *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 299, 302 (Fed. Cir. 1995).

subject matter must be expressly or inherently described in a single prior art reference."[7] "The single reference must describe and enable the claimed invention, including all claim limitations, with sufficient clarity and detail to establish that the subject matter already existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention."[8]

The Office indicates that the McKinnon reference teaches the concept of a carrier virtual network by citing to ¶ [0007] that describes a "shared access carrier network."[9] However, the McKinnon reference does not describe a carrier virtual network that includes layer one resources dedicated from a plurality of dedicating telecommunication networks that each represent particular telecommunication networks of layer one resources exclusive from the others and owned by a respective service provider. Instead, the McKinnon reference describes the shared access carrier network as a network that allows multiple users (end users of the network such as people who interact with computer 44 of FIG. 1) to convey data concurrently over a shared communications medium.[10] This shared access carrier network of McKinnon includes a cable network and an intermediate network that combine to connect the users and service providers, who sell bandwidth on the shared access carrier network.[11] But, the shared access carrier network does not include layer one resources dedicated by plurality of dedicating telecommunication networks, as defined by amended claims 1, 7, and 20. *A fortiori*, the shared access carrier network does not allow for combining dedicated layer one resources managed

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[7] *Elan Pharms., Inc. v. Mayo Foundation for Medical Educ. & Research*, 304 F.2d 1221, 1227 (Fed. Cir. 2002) (citing *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999); *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1571 (Fed. Cir. 1988)).

[8] *Id.* (emphasis added)(citing *Crown Operations Int'l, Ltd. v. Solutia Inc.*, 289 F.3d 1367, 1375 (Fed. Cir. 2002); *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990)). *See also, PPG Indus., Inc. v. Guardian Indus. Corp.*, 75 F.3d 1558, 1566 (Fed. Cir. 1996).

[9] Office Action at pg. 3.

[10] *See McKinnon reference* at ¶ [0003].

[11] *Id.*, at ¶ [0043].

thereby with layer one resources of at least one accessing telecommunication network having layer one resources exclusive from the others and owned by a separate service provider.

As such, for at least the reasons stated above, Applicants contend that claims 1, 7, and 20, as amended, are not anticipated by the McKinnon reference and are in condition for allowance. Each of claims 2-6, 8-19, and 21-31 is believed to be in condition for allowance based, in part, upon their dependency from one of claims 1, 7, 20, respectively, and such favorable action is respectfully requested.[12]

[12] *See* 37 C.F.R. § 1.75(c) (2006).

CONCLUSION

For at least the reasons stated above, each of claims 1-31 is believed to be in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of the claims. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned—by telephone at 816.559.2136 or via email at btabor@shb.com (such communication via email is herein expressly granted)—to resolve the same prior to issuing a subsequent action.

It is believed that no fee is due in conjunction with the present communication. However, if this belief is in error, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 21-0765, referencing attorney docket number SPRI.106553.

Respectfully submitted,

/BENJAMIN P. TABOR/

Benjamin P. Tabor
Reg. No. 60,741

BPT/tq
SHOOK, HARDY & BACON L.L.P.
2555 Grand Blvd.
Kansas City, MO 64108-2613
816-474-6550